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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/586,010	07/12/2006	Glenn Viaplana Gordon	DC10008 PCT 1	1380

137 7590 03/31/2009  
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EXAMINER
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SCOTT, ANGELA C

ART UNIT	PAPER NUMBER
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1796

NOTIFICATION DATE	DELIVERY MODE
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03/31/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents.admin@dowcorning.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/586,010	<b>Applicant(s)</b> GORDON ET AL.	
	<b>Examiner</b> Angela C. Scott	<b>Art Unit</b> 1796	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 March 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

Applicant's response of March 11, 2009 has been fully considered. Claims 1-4 are pending.

#### *Claim Rejections - 35 USC § 103*

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanji et al. (US 2002/0114773).

Regarding claim 1, Kanji et al. teaches a composition containing at least one film forming silicone resin chosen from siloxysilicates (MQ resins) and silsesquioxanes (§54). Kanji et al. states that as used in the specification, the expression "at least one" means one or more and thus includes individual components as well as mixtures and combinations (§1). By this definition, Kanji et al. teaches that the silicone resin of the composition could be comprised of two resins, a siloxysilicate and a silsesquioxane.

Siloxysilicates (the MQ resin) used in the composition are exemplified by trimethylsiloxysilicates, which are represented by the following formula:  $[(CH_3)_3Si-O]_x-(SiO_{4/2})_y$  (MQ units) where x and y can have values ranging from 50 to 80 (§64). A siloxysilicate may also be chosen from any combination of M and Q units, such as, for example,  $[(R)_3Si-O]_x-(SiO_{4/2})_y$ , where R is chosen from a methyl group and longer carbon chains (§64). The entire resin can be made of MQ units giving at least 80 mole % of them.

Silsesquioxanes used in the composition are represented by the following formula:  $(CH_3SiO_{3/2})_x$  where x has a value of up to several thousand and the  $CH_3$  may be replaced (§65) by a longer carbon chain such as an ethane, propane, or butane (§63), therefore teaching the claimed propyl Silsesquioxane resin. All of the  $CH_3$  groups could be replaced with propane giving at least 40 mole % of the substituted groups being propyl. Additionally, the entire resin can be made of  $(CH_3SiO_{3/2})_x$  units giving at least 80 mole % of them.

Kanji et al. additionally teaches the presence of volatile siloxanes in the composition (§96).

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Kanji et al. does not teach that the weight ratio of two resins in a mixture is from 1:99 to 99:1. However, at the time of the invention, a person of ordinary skill in the art would have mixed the resins within this ratio because this ratio simply teaches the presence of two resins in the composition.

Kanji et al. does not teach the specific combination of the above resins in the resin composition. However, at the time of the invention, a person of ordinary skill in the art would have been motivated to pick these two types of film-forming resins and combine them as part of a composition because they each bring different properties to the composition (i.e., the MQ resins are typically harder while the silsesquioxanes are generally continuous and flexible) and combining them can help maximize transfer resistant properties as well as pliability, softness and wearing comfort of the composition.

Regarding claims 2-4, Kanji et al. additionally teaches personal care products such as cosmetics and hair care products (¶12).

### ***Response to Arguments***

Applicant's arguments filed March 11, 2009 have been fully considered but they are not persuasive.

Applicants argue that although a person of ordinary skill in the art may have been motivated to combine an MQ resin and a silsesquioxane, that they would have tried to combine a MQ resin with a T methyl resin and not a T propyl resin because resins containing similar groups would be more compatible. Moreover, Applicants argue that since the combination of the methyl group resins is incompatible, as allegedly evidenced by Table 2 of the instant specification, that one of ordinary skill would not be motivated to try to combine resins with one being a T propyl resin. This argument is found unpersuasive.

Kanji et al. teaches that a combination of resins may be used and teaches a few different resins such as trimethylsiloxysilicate as the MQ resin and T methyl, ethyl, propyl, and butyl resins. Due to this teaching, one of ordinary skill in the art would have been motivated to try any one of those combinations, regardless of the similar group reasoning argued by the Applicants. Additionally, with respect to the showing in Table 2 that MQ resins are incompatible with T methyl resins, Table 2 shows that a combination of a MQ resin with a DT methyl resin provides

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a composition which is hazy and brittle. A DT methyl resin is different from a T methyl resin and therefore it is not clear whether the combination of a MQ resin with a T methyl resin is incompatible. Furthermore, even if the incompatibility exists and that was the first combination one of ordinary skill in the art tried, because of the teaching in Kanji et al., one of ordinary skill would not have necessarily stopped at the MQ resin/T methyl resin combination.

### *Correspondence*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Angela C. Scott whose telephone number is (571) 270-3303. The examiner can normally be reached on Monday through Friday, 8:30am to 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on (571) 272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. C. S./  
Examiner, Art Unit 1796

/David Wu/  
Supervisory Patent Examiner, Art Unit 1796